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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,840	09/01/2000	James K. Beriker	254/180	5735

7590 11/30/2004

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EXAMINER
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LUDWIG, MATTHEW J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 11/30/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/653,840

Applicant(s)

BERIKER ET AL.

Examiner

Matthew J. Ludwig

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 14.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to communications. Request for reconsideration filed June 2, 2004.
2. Claims 1-5 are pending in the case. Claim 1 is an independent claim.
3. The rejection of claims 1-2 under 35 U.S.C. 102(e) as being anticipated by Ryan has been withdrawn pursuant to the Applicant's arguments. The rejection of claims 3-5 under 35 U.S.C. 103(a) as being unpatentable over Ryan in view of Pulliam has been withdrawn pursuant to the Applicant's arguments.

#### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pulliam et al., USPN 6,609,108 filed (4/4/2000) in view of Barrett et al., USPN 6,400,381 filed (6/11/1999).**

**In reference to independent claim 1, Pulliam teaches:**

A consumer desiring to purchase a product first selects and configures the product as desired based upon available product features or options. Dealer inventory and "in-process" product inventory are then searched to locate products that matched or substantially matched the consumer selected product configuration (compare to "*receiving a search criterion from a customer for producing search results*"). See column 6, lines 8-15.

The consumer is then notified that a product has been located and tagged, and may be further notified that the actual purchase or delivery of such product may be conditioned, for example, upon payment or credit verification (compare to “***obtaining and transmitting the search results to the customer***”). See column 6, lines 25-35. The reference provides a reasonable suggestion of both receiving a search criterion and transmitting results of a search criterion to a user. The reference fails to disclose an invitation to be included in the target list related to the search criterion. The Examiner respectfully points out the deficiency in the description of how the target list is constructed or how it is related to the search criterion. Pulliam discloses a report process routine for communicating customer trends, preferences, and other customer-related data; however, the reference does not provide a suggestion of an invitation to be included in the target list related to the search criterion.

Barrett teaches a method for promoting social interaction among computer users displaying similar historical activities on the World Wide Web. Furthermore, the reference discloses activities, which could include particular query terms input to a search engine. A communication grouping is established when the activities of a client computer matches the activities of one or more companion client computers. If there is a match, the chat server notifies the client applets of each client computer in the communication grouping for display (compare to “***transmitting to the customer an invitation to be included in the target list related to the search criterion***”). See column 5, lines 25-67 & column 6, lines 1-36. Because the claim limitations are to be given their broadest reasonable interpretation within the scope of the art, the notification means supplied by the server provides a reasonable suggestion of an invitation sent to users based on similar activities. It would have been obvious to one ordinary skill in the art, having the

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teachings of Pulliam and Barrett before him at the time the invention was made, to modify the user preference methods taught by Pulliam to include the notification means of Barrett, because it would have provided users a way to chat about various products and would have provided the benefit of a personalized sense of community among both manufacturers and customers.

**In reference to dependent claim 2, Pulliam teaches:**

The consumer is then notified that a product has been located and tagged, and may be further notified that the actual purchase or delivery of such product may be conditioned, for example, upon payment or credit verification. See column 6, lines 25-30. The reference discloses contact information requested of the customer based on the acceptance of the purchased product; however, it fails to disclose an acceptance based on the invitation to be included in the target list. Barrett teaches a method for promoting social interaction among computer users displaying similar historical activities on the World Wide Web. Furthermore, the reference discloses activities, which could include particular query terms input to a search engine. A communication grouping is established when the activities of a client computer matches the activities of one or more companion client computers. If there is a match, the chat server notifies the client applets of each client computer in the communication grouping for display (compare to "transmitting to the customer an invitation to be included in the target list related to the search criterion"). See column 5, lines 25-67 & column 6, lines 1-36. Because the claim limitations are to be given their broadest reasonable interpretation within the scope of the art, the **notification** means supplied by the server provides a reasonable suggestion of an **invitation** sent to users based on similar activities. It would have been obvious to one ordinary skill in the art, having the teachings of Pulliam and Barrett before him at the time the invention was made, to modify the user-preference

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methods taught by Pulliam to include the notification means of Barrett, because it would have provided users a way to chat about various products and would have provided the benefit of a personalized sense of community among both manufacturers and customers.

**In reference to dependent claim 3, Pulliam teaches:**

The consumer may be warned that there is a possibility that the vehicle has been tagged or sold to someone who may have purchased the vehicle prior to the consumer's effort to locate and tag the vehicle. See column 6, lines 25-30. The reference provides a suggestion of a confirmation request using the contact information, which in this case would be the verification of the customer's order and payment.

**In reference to dependent claim 4, Pulliam teaches:**

The consumer is then provided an estimated product delivery date. See column 6, lines 35-38.

**In reference to dependent claim 5, Pulliam teaches:**

The system can optionally include a report process routine for communicating customer trend, preference, and other customer-related data to the provider of the product or products offered for sale. See column 7, lines 1-7.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cadez et al.,

USPN 6,771,289

filed (3/2/2000)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 571-272-4127. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-2145.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML  
November 15, 2004



**STEPHEN S. HONG  
PRIMARY EXAMINER**